UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/758,575	SAWADA, KAZUSHIGE
	Examiner	Art Unit	
	David Faber	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *15 January 2004*.
2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-18* is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-18* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All   b)☐ Some * c)☐ None of:
   1.☐ Certified copies of the priority documents have been received.
   2.☐ Certified copies of the priority documents have been received in Application No. _____.
   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   This office action is in response to the application filed 15 January 2004.

This office action is Non-Final.

2.   Claims 1-18 are pending. Claims 1, 8, 11, 14, and 18 are independent claims.

Priority

3.   Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d).

Information Disclosure Statement

4.   The information disclosure statement (IDS) submitted on 15 January 2004 and 1

August 2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the

information disclosure statement is being considered by the examiner.

Drawings

5.   The drawings filed 15 January 2004 has been accepted by the Examiner.

Claim Objections

6.   Claim 6 objected to because of the following informalities:

7.   Claim 6 recites the term "sifting Examiner believes "sifting" is a typographical

error and should be written as "shifting." Therefore, throughout this Office action, Claim

6 will be viewed as "shifting".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

8.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

9.   Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

10.   As per dependent claim 2, Examiner is unsure what the Applicant means exactly

by the limitation, "determines a display area of a page to be displayed next so that the

same display area as that of the given page is displayed." Examiner believes Applicant

is trying to say if that the next page displayed with be displayed in the same display

window as the first page was originally displayed, and has been viewed throughout this

office action.

Claim Rejections - 35 USC § 101

11.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

12.   Claims 1-7, and 15-18 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

For your reference, below is a section from MPEP 2105 :

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material

Per Se or Computer Programs Representing Computer Listings Per Se
**Data structures not claimed as embodied in computer-readable media are descriptive
material per se and are not statutory** because they are not capable of causing functional
change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760
(claim to a data structure per se held nonstatutory). Such claimed data structures do not
define any structural and functional interrelationships between the data structure and other
claimed aspects of the invention which permit the data structure's functionality to be
realized. In contrast, a claimed computer-readable medium encoded with a data
structure defines structural and functional interrelationships between the data structure
and the computer software and hardware components which permit the data structure's
functionality to be realized, and is thus statutory.
Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or
expressions of the programs, are not physical "things." They are neither computer
components nor statutory processes, as they are not "acts" being performed. Such
claimed computer programs do not define any structural and functional interrelationships
between the computer program and other claimed elements of a computer which permit
the computer program's functionality to be realized. In contrast, a claimed computer-
readable medium encoded with a computer program is a computer element which defines
structural and functional interrelationships between the computer program and the rest of
the computer which permit the computer program's functionality to be realized, and is
thus statutory. Accordingly, it is important to distinguish claims that define descriptive
material per se from claims that define statutory inventions.
Computer programs are often recited as part of a claim. Office personnel should
determine whether the computer program is being claimed as part of an otherwise
statutory manufacture or machine. In such a case, the claim remains statutory irrespective
of the fact that a computer program is included in the claim. The same result occurs when
a computer program is used in a computerized process where the computer executes the
instructions set forth in the computer program. Only when the claimed invention taken as
a whole is directed to a mere program listing, i.e., to only its description or expression, is it
descriptive material per se and hence nonstatutory.
**Since a computer program is merely a set of instructions capable of being executed by a
computer, the computer program itself is not a process and Office personnel should treat
a
claim for a computer program, without the computer-readable medium needed to realize
the computer program's functionality, as nonstatutory functional descriptive material.
When a computer program is claimed in a process where the computer is executing the
computer program's instructions, Office personnel should treat the claim as a process
claim. See paragraph IV.B.2(b), below. When a computer program is recited in
conjunction with a physical structure, such as a computer memory, Office personnel
should treat the claim as a product claim.**

13.   Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. The claims appear to be claiming "software

systems" i.e. systems without hardware indication, which is computer program per se.

Since the computer program is not embodied on a tangible computer readable medium,

they appear non-statutory.

14.   Claims 15-18 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. The claims are claiming a computer program

per se. A computer program not embodied on a tangible computer readable medium is

not statutory.

Claim Rejections - 35 USC § 102

15.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16.   Claims 1-7, 11-18 are rejected under 35 U.S.C. 102(b) as being anticipated by

the program Acrobat Reader 5.1 (hereinafter "Acrobat")(Adobe Acrobat Reader 5.1,

released 9/17/2002, SS1-15, pp1-76)

In addition, Examiner provides a copy of the Help file packaged along with Adobe

Acrobat 5.1 when released to the public.

As per independent claim 1, Acrobat discloses a device comprising:

- Display means for displaying a content of a file having a plurality of pages in a

   window. (SS2, 4: Displays the a page of help file that has content which the

   file has multiple files. The status bar in left hand corner of SS2 indicates the #

   of pages in the file)

- Storage means for storing a display area of a given page of the file displayed

   in the file. (pp1, paragraph 1 discloses Acrobat is software used on Microsoft

Windows and Mac OS. It is inherently known either Windows or Mac OS, both

programs, are stored on a computer system, wherein the system has memory

and monitor to view the Acrobat software. Thus, it inherently known when a

user loads a file to be viewed in Acrobat, the file is loaded or "stored" into

memory, and is then visually displayed to the user through the monitor

displayed the pages of the file. SS2 discloses the file displayed after it has

been "stored" in memory. Furthermore, it is inherent that pressing the print

screen saves a screenshot which includes storing the display area of a given

page which was displayed in the window)

- Determination means for determining a display area of a page to be displayed

next in the window, based on the display area of the given page stored in the

storage means. (SS2: shows the current view of the page. The user is

interested in seeing the bottom of the page that is being shown. Thus, the

user can move the mouse over to Navigation Pane (Pg 5) and press the

Thumbnail tab to show the miniature previewed of the document pages (pg

13; SS3-4) SS4 already has the thumbnail tab being shown. Using the

thumbnail of page 1 shown within the Thumbnail tab window, the user can

click the bottom of the page. Doing so changes the display window to refresh

and display the bottom of the page. (as shown in SS4-6) The user can

choose to view other pages, and click on the page using the Thumbnail by

clicking on a page and viewing the page in the display window. (as shown in

SS7))

As per dependent claim 2, Acrobat discloses wherein the determination means determines a display area of a page to be displayed next so that the same display area that of the given page is displayed. (SS4: Using the thumbnail of page 1 shown within the Thumbnail tab window, the user can click the bottom of the page. Doing so changes the display window to refresh and display the bottom of the page. (as shown in SS4-6) The user can choose to view other pages, and click on the page using the Thumbnail by clicking on a page and viewing the page in the display window. (as shown in SS47))

As per dependent claim 3, Acrobat discloses the ability for the display window to be directed to the next page in sequence using status bar by pressing the next page button (pp 8) In addition, when a user clicks on a page in the thumbnail window showing the thumbnails of the pages, the user is send a direction to have that page be viewed in the display window. (SS4-7) Therefore, it is inherent when either the next page button, or a thumbnail is clicked, the computer retrieves the selected page from memory where it currently being stored, and displays the selected page in the display window.

As per dependent claim 4, Acrobat discloses further comprising area selection means for selecting a certain area within the given page displayed in the window (Using the thumbnail of page 1 shown within the Thumbnail tab window, the user can click the bottom of the page. Doing so changes the display window to refresh and display the bottom of the page. (as shown in SS4-6) In addition, the user can scroll the display area down to a certain area within the page or another page using the down button on the right side of the screen. (e.g. SS2, SS3))

As per dependent claim 5, Acrobat discloses wherein the certain area selected by the area selection means is also displayed in a page other the given page. (Using the thumbnail of page 1 shown within the Thumbnail tab window, the user can click the bottom of the page. Doing so changes the display window to refresh and display the bottom of the page. (as shown in SS4-6) The user can choose to view other certain area of the pages. For example, the user wants to see the beginning of Page 6 of the file without using the scrolling method. Thus the user clicks on the top part of page 6 thumbnail in the Thumbnail window that results viewing the certain area of page in the display window the user selected. (SS7).

As per dependent claim 6, Acrobat discloses shifting means for shifting the certain area selected by the area selection means so that the certain area is substantially at the central region of the window (When the user moves the mouse to a certain area of a page such as shown on SS5, and clicks on that area, that area appears in the central region of the display window after the user clicks on the certain area of the page in the thumbnail window as shown in SS6.

As per dependent claim 7, Acrobat discloses searching means for searching text information within the certain area selected by the area selection means over a plurality of pages in the file. (Acrobat allows the user to search for text when the certain area of the page that was selected is in the display window. Pg 20 discloses the method to access the find command where the user can search for text. SS9-15 show the find command being used.

As per independent claim 11, Claim 11 recites similar limitations as in Claim 1, and is similarly rejected under rationale.

- Displaying a given page in the file in the window (SS2)

As per dependent claim 12, Claim 12 recites similar limitations as in Claim 4 and 6 combined, and is similarly rejected under rationale.

As per dependent claim 13, Claim 13 recites similar limitations as in Claim 11, and is similarly rejected under rationale. Furthermore, Acrobat discloses a method further comprising:

- Receiving a keyword associated with selected the certain area (After selecting the certain area, and loading the find command, the user inputs the words "hand tool" into the find command box. The words "hand tool" is in the selected area thus associated, and the words in the find command box is receiving a keyword. (SS9-12)

- Comparing the keyword with text information contained in the certain area corresponding to each page of the file one after another and displaying a page of the file containing the text information in the window if the keyword and the text information match. (SS12-SS15: The user clicks on the button "find" in the find command box with the words "hand tool" Doing so compares the word with the text information within the certain area selected and throughout the whole document for a match between the two. When a match is found, the words are highlighted indicating a find as shown through FIS 13-15.

As per independent claim 14, Claim 14 recites similar limitations as in Claim 11,

and is similarly rejected under rationale.

As per independent claim 15, Claim 15 recites similar limitations as in Claim 11,

and is similarly rejected under rationale.

As per dependent claim 16, Claim 16 recites similar limitations as in Claim 12,

and is similarly rejected under rationale.

As per independent claim 17, Claim 17 recites similar limitations as in Claim 13,

and is similarly rejected under rationale.

As per independent claim 18, Claim 18 recites similar limitations as in Claim 11,

and is similarly rejected under rationale.

Claim Rejections - 35 USC § 103

17.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

18.   Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Acrobat Reader 5.1 (hereinafter "Acrobat")(Adobe Acrobat Reader 5.1, released

9/17/2002, SS1-15, pp1-76).

As per independent claim 8, Acrobat discloses a device comprising:

- A storage unit for storing a form file (pp1, paragraph 1 discloses Acrobat is

    software used on Microsoft Windows and Mac OS. It is inherently known

either Windows or Mac OS, both programs, are stored on a computer system, wherein the system has memory and monitor to view the Acrobat software. Thus, it inherently known when a user loads a file to be viewed in Acrobat, the file is loaded or "stored" into memory, and is then visually displayed to the user through the monitor displayed the pages of the file. SS2 discloses the file displayed after it has been "stored" in memory. Furthermore, Acrobat discloses the use of loading, and filling out forms when the PDF documents are PDF forms in Acrobat (pp38)

- A display unit for displaying the form file stored in the storage unit in the units of a page (pp1, paragraph 1 discloses Acrobat is software used on Microsoft Windows and Mac OS. It is inherently known either Windows or Mac OS, both programs, are stored on a computer system, wherein the system has memory and monitor to view the Acrobat software. Thus, a user would be able to use the monitor to view a file such shown in the example of SS2. In addition, this would apply to PDF forms when one is loaded in Acrobat)

- a display determination unit for determining a display area of the form file on the display unit so that the display area is fixed to the same position within the form when the page is switched to another page. SS2: shows the current view of the page. The user is interested in seeing the bottom of the page that is being shown. Thus, the user can move the mouse over to Navigation Pane (Pg 5) and press the Thumbnail tab to show the miniature previewed of the document pages (pg 13) (SS3-4) SS4 already has the thumbnail tab being

shown. Using the thumbnail of page 1 shown within the Thumbnail tab window, the user can click the bottom of the page. Doing so changes the display window to refresh and display the bottom of the page. (as shown in SS5-6) The user can choose to view other pages, and click on the page using the Thumbnail by clicking on a page and viewing the page in the display window. (as shown in SS7) The display area is fixed to the same position throughout when changing pages to view. In addition, this would apply to PDF forms when one is loaded in Acrobat)

However, Acrobat discloses within his Help files wherein a single page generated conforming to a given regular page corresponds to a single page and a plurality of pages composes a single file. (SS2-SS4) However, Acrobat fails to specifically disclose wherein a single form page generated conforming to a given regular form corresponds to a single page and a plurality of form pages composes a single file. It was well-known to one of ordinary skill in the art at the time of Applicant's invention that a electronic form file may contain a plurality of pages. Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified Acrobat's with the disclosure above since Acrobat would know if the file contain multiple pages or a single page and have displayed one page at time of a file with multiple pages in the display window provided the benefit of Acrobat allowing the ability to the user to manage and fill-in forms, informing the user the number of pages in the file through the thumbnail window or status bar and able to access the pages without excessive time delays.

As per dependent claim 9, Acrobat discloses a direction unit for directing the display determination unit to place an area within the form in the central region in the central region of the display area. (Acrobat discloses the ability for the display window to be directed to the next page in sequence using status bar by pressing the next page button (pp 8) In addition, When the user moves the mouse to a certain area of a page such as shown on SS5, and the user clicks on a page in the thumbnail window showing the thumbnails of the pages, the user is send a direction to have that page be viewed in the display window as that area appears in the central region of the display window after the user clicks on the certain area of the page in the thumbnail window as shown in SS6. Thus, it has a direction unit.)

As per dependent claim 10, Acrobat discloses:

- a selection unit for specifying a given area within the form as a selection area, and (Using the thumbnail of page 1 shown within the Thumbnail tab window, the user can click the bottom of the page. Doing so changes the display window to refresh and display the bottom of the page. (as shown in SS4-6) The user can choose to view other certain area of the pages. For example, the user wants to see the beginning of Page 6 of the file. Thus the user clicks on the top part of page 6 thumbnail in the Thumbnail window that results viewing the certain area of page in the display window the user selected. (SS7). Thus, Acrobat has a selection unit for specifying a area to view in the display window.)

- A searching unit for searching text information within the selection area

  specified by the selection unit over a plurality of form pages in the form file.

  (Acrobat discloses the ability to search for text within the selected area

  specified by the user, and throughout the whole document. Pg 20 discloses

  the method to access the find command where the user can search for text.

  SS9-15 show the find command being used.)

Conclusion

19.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

- Yoshida (US Patent #7,051,289): Discloses allowing the user to move to an

  area to which the user desires to display in a page to which the user desires

  to move by a single manipulation and to allow next page/preceding page

  operation to be done only by a mouse operation

- Rowe et al (US Patent #5,737,599): Discloses a program capable of

  displaying multi-page documents.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to David Faber whose telephone number is 571-272-2751.

The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

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